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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/616,301

07/10/2003

Yoav Kimchy

25854

1622

67801

7590

10/07/2008

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EXAMINER

CHAO, ELMER M

ART UNIT

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3737

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/616,301	Applicant(s) KIMCHY ET AL	
	Examiner ELMER CHAO	Art Unit 3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/24/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8 and 16 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-8 is/are rejected.
- 7) ☒ Claim(s) 1-4 and 6-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Acknowledgement is made of the amendment filed 9/24/2008.

Election/Restrictions

2. Newly submitted claim 16 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 16 recites a method that does not necessarily require the device of claim 1.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 16 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

3. Applicants' arguments filed 9/24/2008 with respect to claims 1-4 and 6-8 have been considered but are moot in view of the new ground(s) of rejection.

Regarding Applicants' arguments with respect to page 6, paragraph 2, of the Remarks filed 9/24/2008, Examiner feels that it is necessary to correct Applicants' statement regarding what the Examiner agreed with during the phone interview conducted on 9/4/2008. During the interview, Examiner was given a description of a highly detailed invention that was beyond the language of claim 1. This description included at least *functional* differences between the intended function of the invention and those of the references. Examiner only provided Applicants with the opinion that

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the concept *as described* by the representative over the phone (Mr. Fenster) *may* be novel over the former rejection filed 6/25/2008. Examiner also stated that a further search and consideration would be required. Please refer to the interview summary record filed 9/30/2008.

Examiner has provided a new grounds of rejection and advises Applicants to amend accordingly to convey their invention. Applicants are reminded that claims 1-4 and 6-8 are claims directed to an apparatus and Examiner can only interpret them as such.

Claim Objections

4. **Claims 1-4 and 6-8** are objected to because of the following informalities: In claim 1, "radiopharmaceutical" is spelled incorrectly. Appropriate correction is required.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. **Claims 1-4, 6, and 7** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/240,239 in view of Houzego et al. (U.S. 6,632,216 B2). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of Application 10/240,239 disclose all of the required limitations except for circuitry to determine location and orientation of the probe. However, Houzego et al. teach a capsule probe with location and orientation tracking (col. 1, lines 40-44). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include circuitry to detect location and orientation in order to determine the exact location that the image is being obtained (col. 1, lines 40-44).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. **Claim 1** is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, 8, 9, 12, and 13 of copending Application No. 11/132,320 in view of Houzego et al. (U.S. 6,632,216 B2). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of Application 11/132,320 disclose at least all of the required limitations except for circuitry to determine location and orientation of the probe.

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However, Houzego et al. teach a capsule probe with location and orientation tracking (col. 1, lines 40-44). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include circuitry to detect location and orientation in order to determine the exact location that the image is being obtained (col. 1, lines 40-44).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-4, 6, and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Raylman et al. (U.S. 6,076,009), henceforth referred to as Raylman '009, in view of Raylman et al. (U.S. 6,236,880 B1), henceforth referred to as Raylman '880.

Regarding **claims 1, 3, 4, 6, and 7**, Raylman '009 teach an ingestible device (fig. 2, item 1) for diagnosing body cavities comprising: a probe, operative to acquire, along said gastrointestinal tract (col. 19, lines 35-40), a diagnostic image of nuclear radiation of a radiopharmaceutical (col. 19, lines 40-44); data-handling apparatus, in

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signal communication with said probe, for receiving and handling imaging data, generated by said probe (fig. 2, item 13); a power source, for powering said probe and data-handling apparatus, and power source within (fig. 4, item 70), wherein said ingestible device comprises a plurality of nuclear-radiation detectors, arranged around said probe (fig. 8 & 9, items 30 & 40; col. 19, lines 40-44).

Raylman '009 teach the limitations as discussed above but fail to explicitly teach circuitry with a sensor to determine location and orientation of the ingestible device. However, in the same field of endeavor, Raylman '880 teach determining location and orientation of the tip of the ingestible device (col. 9, lines 62-67, refer to the operator determining the orientation). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the process of determining the location and orientation of the tip of the ingestible device in order to free the operator of the task. Such a modification is considered automating a manual activity (for motivation see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194) and can be conducted with surgical tracking systems well-known in the art.

Regarding **claim 2**, Raylman '009 teach the nuclear radiation detectors arranged for detecting gamma and beta radiation (col. 3, lines 61-65)

10. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Raylman '009 in view of Raylman '880, further in view of Zhang et al. (Society of Nuclear Medicine, June 2000). Raylman '009 and Raylman '880 teach the limitations as discussed above but fail to explicitly teach an ingestible device arranged as a Compton

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camera. However, in the same field of endeavor, Zhang teaches a transrectal imaging probe based on Compton camera techniques (No. 68, second sentence). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the invention to include a Compton camera probe as evidenced by Zhang. Such a modification would allow the ingestible device to have high sensitivity and high resolution (No. 68, second sentence).

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELMER CHAO whose telephone number is (571)272-0674. The examiner can normally be reached on 9am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (571)272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRIAN CASLER/
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/E. C./
Examiner, Art Unit 3737
10/1/2008